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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,208	02/13/2004	Frederico G. Jaekel	076029-0303290	2479

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PILLSBURY WINTHROP SHAW PITTMAN, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

EXAMINER

MORRIS, LESLEY D

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/777,208

Applicant(s)

JAEKEL ET AL.

Examiner

Avraham Lerner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 8-34 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 35-37 and 39-46 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent-Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0204.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group I and species C in the reply filed on May 16, 2005 is acknowledged. The traversal is on the grounds that there would be no serious burden on the examiner to search and treat the independent and distinct inventions. This is not found persuasive because a serious search burden is established by virtue of the different classification of the various inventions. The examiner also notes that, contrary to applicant's claim listing, the structure of claim 38 is inconsistent with the elected species, and therefore this claim will not be considered. Claims 1-7, 35-37, and 39-47 will be treated on the merits herein.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102/103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McCoy et al. (U.S. Patent Application Publication No. 2004/0061310).

McCoy et al. discloses a hitch assembly having all elements as claimed, including a hitch mounting structure having a general U-shape with opposing end portions and a centrally disposed intermediate portion between the end portions; and a hitch receiver mounted to the intermediate portion of the hitch mounting structure, wherein the end portions each include a mounting section with a general L-shaped cross-sectional configuration (see e.g. Fig. 1), thereby providing the end portions with horizontally extending mounting flanges structured to mount the hitch assembly to the frame assembly of the vehicle, each of the horizontally extending mounting flanges include a plurality of openings for mounting the hitch assembly to the frame assembly of the vehicle, the intermediate portion of the hitch mounting structure including an opening structured to mount the hitch receiver, and wherein the intermediate portion has a general V-shape (to the same extent as that of applicant) such that the end portions are positioned higher than the opening in the intermediate portion (see Fig. 1, located at the bottom of the intermediate portion). With respect to the limitation that the hitch is a one-piece mounting structure, this is considered a product-by-process limitation. As written in the MPEP 2113, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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5. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Westerdale (U.S. Patent Application Publication No. 2004/0021295 A1).

Westerdale discloses a hitch assembly having all elements as claimed, including a hitch mounting structure having a general U-shape with opposing end portions and a centrally disposed intermediate portion between the end portions; and a hitch receiver mounted to the intermediate portion of the hitch mounting structure, wherein the end portions each include a mounting section with a general L-shaped cross-sectional configuration (see e.g. Fig. 1), thereby providing the end portions with horizontally extending mounting flanges structured to mount the hitch assembly to the frame assembly of the vehicle, the body and intermediate portion having a rectangular cross section, each of the horizontally extending mounting flanges include a plurality of openings for mounting the hitch assembly to the frame assembly of the vehicle, the intermediate portion of the hitch mounting structure including an opening structured to mount the hitch receiver. With respect to the limitation that the hitch is a one-piece mounting structure, this is considered a product-by-process limitation. As written in the MPEP 2113, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

6. Claims 35-37, 39, 40, 42, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westerdale in view of Grice (U.S. Patent No. 5,011,177).

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Westerdale discloses a hitch assembly having all elements as claimed, as recited above in detail, except for inner and outer hitch member telescopically mounted for sliding movement, and a reversible electric motor and gear arrangement operable to drive the inner receiver relative to the outer receiver.

Grice discloses that it is known in the art to provide a inner hitch mounted inside an outer hitch receiver whereby the two members are telescopically connected via a motor (50) and rack (30) and gear assembly (see especially Fig. 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the hitch assembly of Westerdale with motorized inner and outer hitch members as taught by Grice in order to enable a user to more easily mate a towing vehicle with a trailer. Such a modification would have permitted a length adjustment of the hitch assembly, thereby facilitating connection of the two vehicles without requiring either vehicle to be moved in its entirety and therefore would have been obvious to one of ordinary skill.

7. Claims 35-37 and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al. in view of Grice.

McCoy et al. discloses a hitch assembly having all elements as claimed, as recited above in detail, except for inner and outer hitch member telescopically mounted for sliding movement, and a reversible electric motor and gear arrangement operable to drive the inner receiver relative to the outer receiver.

Grice discloses that it is known in the art to provide a inner hitch mounted inside an outer hitch receiver whereby the two members are telescopically connected via a motor (50) and rack (30) and gear assembly (see especially Fig. 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the hitch assembly of McCoy et al. with motorized inner and outer hitch members as taught by Grice in order to enable a user to more easily mate a towing vehicle with a trailer. Such a modification would have permitted a length adjustment of the hitch assembly, thereby facilitating connection of the two vehicles without requiring either vehicle to be moved in its entirety and therefore would have been obvious to one of ordinary skill.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al. in view of Tomika (U.S. Patent No. 6,729,639).

As recited above in detail, McCoy et al. discloses the claimed invention except for the end portions having elbow sections with a general U-shaped cross section.

Tomita discloses that it is known in the art to provide a hitch mounting assembly with elbow sections having generally U-shaped cross section.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the end portions of McCoy et al. with a U-shaped configuration as taught by Tomita in order to improve the strength of the hitch/vehicle mounting. Note column 1, last full paragraph of Tomita, which details that such a structure "greatly improves the stiffness of the vehicle body structural member and enables the vehicle body structural member to withstand a heavy load."

9. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al. and Grice as applied to claim 36 above, and further in view of Tomita (U.S. Patent No. 6,729,639).

As recited above in detail, McCoy et al. and Grice disclose the claimed invention except for the end portions having elbow sections with a general U-shaped cross section.

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Tomita discloses that it is known in the art to provide a hitch mounting assembly with elbow sections having generally U-shaped cross section.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the end portions of McCoy et al. with a U-shaped configuration as taught by Tomita in order to improve the strength of the hitch/vehicle mounting. Note column 1, last full paragraph of Tomita, which details that such a structure "greatly improves the stiffness of the vehicle body structural member and enables the vehicle body structural member to withstand a heavy load."

#### *Allowable Subject Matter*

10. Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bettenhausen (U.S. Patent No. 6,234,512), Pogue (U.S. Patent No. 6,871,868), Aquinto et al. (U.S. Patent Application Publication No. 2002/0041078), and McCoy et al. (U.S. Patent No. 6,540,277) disclose trailer mounting or motorized hitch assemblies.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avraham Lerner whose telephone number is (571) 272-6647. The examiner can normally be reached on M-F (8:15-5:45) first Wednesday off.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



August 8, 2005

**LESLEY D. MORRIS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**